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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,250	07/30/2001	Keiichi Takagaki	TAN-291	8651

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SHERMAN & SHALLOWAY  
413 North Washington Street  
Alexandria, VA 22314

EXAMINER

KAM, CHIH MIN

ART UNIT PAPER NUMBER

1653

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

95  
**Office Action Summary**

Application No.

09/916,250

Applicant(s)

TAKAGAKI, KEIICHI

Examiner

Chih-Min Kam

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.  
2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.  
    4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
    a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
        1. ☒ Certified copies of the priority documents have been received.  
        2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of the Claims***

1. Claims 1-3 are pending.

Applicants' amendment filed November 10, 2003 is acknowledged, and applicants' response has been fully considered. Claims 1-3 have been amended. Thus, claims 1-3 are examined.

### **Rejection Withdrawn**

#### ***Claim Rejections - 35 USC § 112***

2. The previous rejection of claims 1-3 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicants' amendment of the claim, and applicants' response at pages 3-4 in the amendment filed November 10, 2003.

#### ***Claim Rejections - 35 USC § 102***

3. The previous rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by Miller *et al.* (Biochemistry 11, 4903-4909 (1972)), is withdrawn in view of applicants' amendment of the claim, and applicants' response at pages 4-6 in the amendment filed November 10, 2003.

4. The previous rejection of claim 1 under 35 U.S.C. 102(e) as being anticipated by Rueger *et al.* (U. S. 2001/0016646, filed March 20, 1998), is withdrawn in view of applicants' amendment of the claim, and applicants' response at pages 7-9 in the amendment filed November 10, 2003.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-3 are directed to a method for preparation of crude proteoglycan comprising extracting cartilage with a solution of acetic acid of 4% or more to obtain crude proteoglycan. The specification indicates that the desirable concentration of the acetic acid eluting solvent is approximately 4% (page 4, last paragraph), and the Example also indicates 4% acetic acid is used to extract the crude proteoglycan from cartilage (page 5). However, the specification does not describe the use of acetic acid at a concentration higher than 4%. Furthermore, there is no example demonstrating the advantage of using higher concentration (> 4%) of acetic acid. Since the specification does not provide sufficient description of using acetic acid at a concentration higher than 4%, one skilled in the art would not know the advantage of using higher concentration of acetic acid. The lack of description of the effect of acetic acid at a concentration >4% in extracting proteoglycan, and the lack of representative species for the concentrations greater than 4% as encompassed by the claims, applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise terms that a skilled artisan would not recognize applicants were in possession of the claimed invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1653

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is indefinite because the claim recites dissolving the precipitate containing crude proteoglycan in a solution of acetic acid, but it does not indicate what concentration of the acetic acid solution is used.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller *et al.* (Biochemistry 11, 4903-4909 (1972)).

Miller *et al.* teach a method for preparing collagen, where the proteoglycan components are removed from the fresh cartilage slices by first extraction with 0.05 M Tris, 1.0 M NaCl, pH 7.5 for 5 successive days, and then extracting with 0.5 M (corresponding to 3%) acetic acid employing the same protocol as for the neutral salt (page 4904, left column, paragraph 4; claim 1). Although Miller *et al.* do not disclose the use of 4% acetic acid (corresponding to 0.667 M) in extracting proteoglycan, at the time of invention was made, it would have been obvious to one of ordinary skill in the art to use higher concentration of acetic acid for extracting because the

Art Unit: 1653

higher concentration of acetic acid solution may shorten the extraction time for producing the same effect as 0.5 M (3%) acetic acid. Thus, the teaching of the reference results in the claimed invention and was, as a whole, prima facie obvious at the time the claimed invention was made.

***Conclusion***

8. No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571) 272-0951. The fax phone numbers for the

Art Unit: 1653


organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D. *CMK*  
Patent Examiner

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February 10, 2004



ROBERT A. WAX  
PRIMARY EXAMINER